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09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

This final rejection is in response to Applicant's arguments and supplemental responses filed on 1/20/2011, 3/24/2011, 9/7/2011, and 12/26/2011. Applicant previously cancelled claims 1-15, 21, 23-102, 104, 134-147, 150, and 151. Accordingly, Applicant presents claims 16-20, 22, 103, 105-133, 148, and 149 are presented for further examination.

I. RESPONSE TO ARGUMENTS

A. Requirements under 37 C.F.R. § 1.131

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. MPEP § 715.07. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *Id* (citing *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974)). Moreover, Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. *Id* (citing 505 F.2d at 718-19, 184 USPQ at 33).

B. Applicant's response filed on 1/20/2011

Applicant argues that the examiner did not give proper weight to the declaration filed on 10/6/2009. Applicant argues that "[a] screen shot has been submitted and authenticated to show the encryption feature." However, no declarations filed prior to 1/20/2011 provide a screen shot

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illustrating that an instant message sent from a user of one realm to a second user of another realm is encrypted.

1. The declaration filed on 11/15/2004 describe the initial difficulty in attempting to contact the inventor Kevin Donovan and does not provide a screen shot.
2. The declarations filed on 10/12/2006 were declarations of computer science professors arguing against the proposed combination of references in an Office action and did not provide a screen shot.
3. The declarations filed on 8/16/2007 were second declarations from the same professors and did not provide a screen shot.
4. The declaration filed on 10/3/2008 provided an article detailing Prodigy's unveiling of their instant messaging product but did not provide a screen shot of the instant messaging system.
5. On page 2 of Applicant's response filed on 5/26/2009, Applicant does reference the screen shot as being part of a supplemental declaration that was "submitted herewith." However, there is no record of any supplemental declaration received by the Office on 5/26/2009.
6. The declaration filed on 10/6/2009 references a "screen shot as set out in Kevin Donovan's Supplemental Declaration" but again there is no record of a supplemental declaration from Kevin Donovan - the only declaration received from Kevin Donovan was received on 10/3/2008 and that declaration only provided an article describing the unveiling of the instant messaging product.

As highlighted above, there is no declaration that provides a screen shot or any other support for the encryption feature. Without the screen shot or some other evidence that provides support for the encryption feature, Applicant's argument amounts to nothing more than a general statement that the invention was completed.

This is particular the case for the declaration of 10/6/2009 which provides the general statement that the declarant tested the encrypting feature. But with no proof or other facts, this statement is nothing more than an unsupported assertion. And this is particularly important because one of ordinary skill in the art would not generally assume that the encrypting feature would take place at the user interface level. That is, encryption of messages usually occurs at a lower level than the application (i.e., interface level).

Therefore, if Applicant's position is that the encryption takes place at the user interface level which could be proven by a mere screen shot, then the screen shot is of vital importance because this would generally contradict the knowledge of one of ordinary skill in the art.

Moreover, the declaration of Aviel Rubin filed on 10/12/2006 describes that encrypting messages between two different realms was contrary to what one of ordinary skill in the art would have done at the time of Applicant's invention (see page 3, items 9-11). The crux of Rubin's statements are that the encryption feature is novel because encrypting an instant message that is sent between two different realms was a "burgeoning field" and contrary to what messaging service providers would have wanted.

Therefore, because the encryption feature is so allegedly unique to the instant messaging field which "would not have been [sic] common skill for an instant messaging programmer to have had in 1999" (Rubin declaration 10/12/2006, pg. 3, item 10), the encryption feature must

clearly be demonstrated by clear facts and not merely general statements in the declarations. *See* MPEP § 715.07. Donovan and Rader's mere statements that the encryption step was completed prior to May 5, 1999 does provide the facts necessary to support the encryption feature.

C. Applicant's response and Second Rader declaration filed on 3/24/2011

The declaration recites that Rader "personally used the screen in the screen shot reference at page 6 of Kevin Donovan's declaration of 5/28/2009." This statement is unsupported because 1) there is no declaration of 5/28/2009 and 2) the only declaration from Kevin Donovan was received on 10/3/2008 which did not contain a screen shot of the encrypting feature.

The rest of the declaration also lacks this screen shot that provide support for the encryption feature. Pages 20-51 and 62 of the declaration do provide screen shots but none of them describe or provide support for encrypting an instant message that is sent between two different realms.

1. Page 20 illustrates a user profile where a user can sign in to his AIM account and that the user can "keep in touch" with his Prodigy friends. However, there is no illustration that the instant message sent by the user to his Prodigy friends is encrypted;

2. Page 21 illustrates chat rooms;

3. Pages 22 and 23 are too dark and the images cannot be properly discerned;

4. Pages 24 and 25 illustrate a file transfer feature;

5. Pages 26-30 illustrate buddy list features;

6. Page 31 illustrates a preferences interface that enable a user to customize sounds, nickname, and other features;

7. Pages 32-36 illustrate help pop-ups for the user;
8. Pages 37-44 illustrate a conversation interface. However none of the options in the interface specify or describe encrypting messages sent between the users of the conversation;
9. Pages 45-51 illustrate profile customization features;
10. Page 62 provides images of a buddy list and chat conversation. Again, there is no description that an instant message is encrypted between the users.

These screen shots however do not provide clear support for the encryption feature.

C. Applicant's response filed on 9/7/2011

Applicant argues that *Walker* does not disclose "associating said first and second users with a first realm and a second realm respectively." However, Applicant's argument ignore the rejections reliance on *Walker*'s teaching that an expert (i.e., a second user) may connect to the online service in the same manner as an end user (i.e., through a messaging provider such as AOL, Compuserve, Prodigy) but may use "a different channel of communications" for greater security [*Walker*, column 28 «lines 5-11»].

Moreover, *Walker* expressly discloses that users may connect to the network using America Online, Compuserve, or Prodigy which allows "end users access from a wide range of online connections" [column 15 «lines 27-31»]. *Walker* clearly contemplates an embodiment where multiple users may connect to the same service but through different messaging providers (i.e., through a "wide range of online connections").

These citations in combination clearly suggest to one of ordinary skill in the art an end user connected to the on-line service using one messaging provider (i.e., a first user in a first

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realm) and an expert connected to the on-line service using another messaging provider (i.e., a second user in a second realm). In other words, *Walker's* invention acts as a bridge between users of different messaging providers such as America Online, Compuserve, or Prodigy, and allows these users to exchange messages [column 15 «lines 36-39»].

Applicant then argues that *Busey* does not disclose a communicating from one protocol to another. However, the rejection relies on *Busey* to disclose the limitation of “each realm being accessible via the Internet using a protocol characteristic to the realm” and not necessarily for the feature of a first and second user in two different realms.

In this regard, *Busey* discloses detecting a protocol characteristic to determine the messaging provider (e.g., Telnet, IRC) used by each end user. This teaching reads on the protocol characteristic feature of Applicant’s claim. Therefore, the combination of *Walker* and *Busey* read on the limitations of claims 16, 108, 114, 118, 125-127, and 149.

D. Applicant’s response filed on 12/26/2011

Applicant provides a supplemental declaration titled “Prodigy Instant Messaging Exploration.” Contrary to the requirements set forth in MPEP § 715.07, Applicant does not provide any specific citations as to which portion of the declaration provides support for the encryption feature.

The declaration seems to be review of the user interface practices involved with Prodigy’s instant messaging service. There does not seem to be any discussion of the feature where a message is encrypted between two different realms. If the examiner has missed this support, Applicant should cite the specific page and section that does describe support this feature.

E. Conclusion

Applicant's declarations and arguments with respect to the encryption feature hinge entirely on a "screen shot" that was allegedly part of " Kevin Donovan's declaration of 5/28/2009." However, as highlighted above, there is no screen shot that has been included in any declarations filed by Applicant. Therefore, without any corroborating evidence, Rader and Donovan's statements amount to nothing more than general assertions that are "unsupported by proof or a showing of facts." *See* MPEP § 715.07(I).

For at least the foregoing reasons, Applicant's declarations do not satisfy the requirements of 37 C.F.R. 1.131(b). To overcome this determination, Applicant must provide proof or facts that clearly establish or describe the encryption feature as between two different realms. The rejections as set forth in the previous action are maintained.

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II. CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. Claims 16, 108, 114, 118, and 125, 126, 127, and 149 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walker et al.*, U.S. Patent No. 5,862,333, in view of *Busey et al.*, U.S. Patent No. 7,165,213 [*"Busey"*].

Claim 16

Walker as modified by *Busey* discloses a method of a method of conducting an instant messaging session between a first user and a second user over the Internet [*Walker*, column 26 «lines 40-44»: “real-time text messaging” between end-user and an expert], the method comprising:

associating said first and second with a first realm and a second realm respectively [*Walker*, column 27 «lines 4-8» | column 28 «lines 7-8»: end user and expert may sign on to different online service providers], each realm being accessible via the Internet using a protocol characteristic to the realm [*Busey*, column 5 «lines 11-14»: chat server capable of connecting clients of different protocols including Telnet and IRC], each said user getting access to the Internet via one of a respective first and second device [*Walker*, Fig. 17 «items 1700, 1705: end user connects via AOL, CompuServe, prodigy | column 28 «lines 5-11»: expert connects to an online service in the same manner as end user], at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm [*Busey*, column 15 «lines 18-32»: chat server stores particular protocols used by the client to establish the session]

establishing a connection between said first and second users using a current IP address [Walker, column 15 «lines 36-37: internet protocols implies IP address] and said protocol characteristic of said second user as part of an instant messaging session [Busey, column 15 «lines 18-32»]; and

encrypting an instant message sent between the devices during the instant messaging session [Walker, column 10 «lines 54-61»: encrypting messages to ensure privacy].

As noted above, while Walker discloses that the end-user and expert may sign on to different service providers, Walker does not disclose the use of a protocol characteristic and storing the protocol characteristic in a storage media.

However, these features were well known in the art at the time of Applicant's invention as evidenced by Busey. Busey discloses each realm (i.e., service provider such as AOL, CompuServe, Prodigy as taught in Walker) is accessible using a protocol characteristic to determining which protocol is being used by the user. It would have been obvious to one of ordinary skill in the art to have modified Walker to include the protocol characteristic taught by Busey. Since Walker discloses that users may sign into different service providers, the protocol characteristic (which Busey uses to determine whether a client is a IRC or telnet client) would be useful to determine which provider Walker's users are signed into.

Claim 108

Claim 108 is rejected for at least the same reasons set forth for claim 16.

Claim 114

Claim 114 is rejected for at least the same reasons set forth for claim 16.

Claim 118

Claim 118 is rejected for at least the same reasons set forth for claim 16.

Claims 125, 126, 127, and 149

Walker as modified by *Busey* discloses said realms comprise Internet service providers [*Walker*, column 27 «lines 4-8»].

B. Claims 16-20, 22, 103, 105-111, 114-127, and 149 are rejected under 35 U.S.C § 103(a) as being unpatentable over *Auerbach* in view of *Aravamudan* et al, U.S Patent No. 6.301.609 [“*Aravamudan*”], in view of *Gudjonsson*.

All citations are to *Auerbach* unless otherwise expressly noted in the rejection.

Claim 16

Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising:

associating said first and second with a first realm and a second realm respectively [column 2 «lines 9-15» : different users, different service providers], each realm being accessible via the Internet using a protocol characteristic to the realm (col. 2, lines 19-28), each said user getting access to the Internet via one of a respective first and second device (fig. 3, client 102), at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm (see fig. 3, protocol services 130 and 132);

establishing a connection between said first and second users [column 7 «line 65» to column 8 «line 27»], using a current IP address and said protocol characteristic of said second user as part of an instant messaging session [*Aravamudan*, column 9 «lines 45-57» | column 11 «lines 8-45»]; and

encrypting an instant message sent between the devices during the instant messaging session [Gudjonsson, column 2 «lines 16-23» | column 11 «lines 38-43» where: *Gudjonsson's* servers are interpreted as Applicant's "devices"].

While *Auerbach* discloses the user logging on to the primary service provider using established logon procedures, and *Auerbach* does not specifically disclose the steps of (1) establishing a connection between the first and second users using a current IP address and the protocol characteristic of said second user and (2) encrypting instant messages.

1. *Auerbach* implicitly and *Aravamudan* expressly discloses using an IP address and protocol characteristic for establishing a connection between the users.

As discussed previously, the use of IP addresses to connect network users is implicit in *Auerbach*. *Auerbach* clearly discloses establishing network sessions between the users through his conversion platform; the platform would necessarily need to know the IP addresses of each user to do so. Further, *Auerbach* discloses establishing sessions based on the email addresses of users [column 1 «lines 46-61»]. It is well known in the art that email addresses are inherently tied to IP addresses.

Moreover, in the same field of invention, *Aravamudan* discloses establishing a connection between said first and second users using said current IP address and said protocol characteristic as part of an instant messaging session. It would have been obvious to one of ordinary skill in the art to have reasonably inferred that *Auerbach's* sessions were established using a user's IP address based on *Aravamudan's* express teaching since IP addresses were well known in the art for identifying user computers.

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2. *Gudjonsson* discloses encrypting instant messages between users during an instant messaging session.

Auerbach does not expressly disclose encrypting instant messages. In a related field of invention *Gudjonsson* is directed towards establishing communication sessions between users over a variety of networks. *Gudjonsson* discloses encrypting an instant message during the instant message session. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into *Auerbach*'s communication system for the desirable function of having secured transmissions of network messages between users.

Claim 17

Auerbach as modified by *Aravamudan* discloses sending a message to the IM database indicating the corresponding user is online [*Aravamudan*, column 9 «line 64» to column 10 «line 15»].

It would have been obvious to modify *Auerbach*'s to include the steps of sending a message to an IM database indicating the corresponding user is online in order to more accurately track user relationships and maintain knowledge of the users and processes on the system. Therefore, the limitations would have been an obvious modification *Auerbach*'s system.

Similar motivation applies to claims 18-20.

Claim 18

Auerbach as modified by *Aravamudan* discloses retrieving said address form said IM database [*Aravamudan*, column 5 «lines 25-31» | column 6 «lines 18-31» | column 9 «lines 49-57»].

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Claim 19

Auerbach as modified by *Aravamudan* discloses sending a connection request from the first to the second device for establishing said instant messaging session [*Aravamudan*, column 9 «lines 10-22»].

Claim 20

Auerbach as modified by *Aravamudan* discloses generating a response to said connection request by said second device accepting said connection request [*Aravamudan*, column 9 «lines 10-22» | column 10 «lines 37-44» | column 11 «lines 35-45»].

Claim 22

Auerbach discloses displaying a window on the screen of the first and second devices, the window indicating a list of active users (see Fig 4B).

Claim 103

Auerbach as modified by *Aravamudan* discloses displaying a window with a message area, said message area being used to indicate messages between said users [column 10 «lines 37-41»].

Claims 105-107, 109-111, 115-117, and 119-121

Auerbach discloses a handheld and palmtop computer [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : “consumer electronics”].

Claim 108

Auerbach discloses a method of conducting an instant messaging session, the method comprising:

establishing an instant messaging session over an Internet protocol network between

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a first user device and a second user device [column 1 «lines 46-61»], each of the user devices correspond to a user name [Figures 4A, 4B.], each of the user names correspond to a different realm [column 2 «lines 26-32»] , each of the user devices having an Internet Protocol address in the realm corresponding to the user name [Figure 4B | column 2 «lines 26-32»].

Auerbach does not expressly disclose (1) each said user device having an Internet protocol address in the realm corresponding to the user name and (2) encrypting instant messages. See the rejection of claim 16 for reasons to combine *Auerbach*, *Aravamudan*, and *Gudjonsson*.

Claim 114

Auerbach as modified by *Aravamudan* and *Gudjonsson* discloses an instant message communications apparatus comprising:

a first user device connected to an Internet Protocol network, the first user device associated with a first Internet Protocol address, a first user name, and a first realm [*Auerbach*, abstract: “individuals...may be subscribers to different service providers” & *Aravamudan*, Fig. 5 «item 236»: disclosing user address];

a second user device connected to the Internet Protocol network, the second user device associated with a second Internet Protocol address, a second user name, and a second realm [*Auerbach*, abstract: “individuals...may be subscribers to different service providers” & *Aravamudan*, Fig. 5 «item 236»: disclosing user address];

a database storing realm protocols connected to at least one of the first user device and the second user device [*Auerbach*, Fig. 3 «item 112»: conversion protocol containing SP1 and SP2 protocol services];

the first user device connected to the second user device with a suitable instant messaging protocol communicates an encrypted instant message between the first user device in the first realm and second user device in the second realm over the connection [*Gudjonsson*, column 2 «lines 16-23» | column 11 «lines 38-43» where: *Gudjonsson*'s servers are interpreted as Applicant's "devices"]; and

a display screen of each of the first and second user devices displays the instant message [Fig. 1 «item 36»].

See rejection of claim 16 for reasons to combine *Auerbach*, *Aravamudan*, and *Gudjonsson*.

Claim 118

As to claim 118, as it does not teach or further define over the previously claimed limitations it is similarly rejected for at least the same reasons set forth above for claims 108 and 112.

Claims 122 and 125

Auerbach as modified by *Aravamudan* and *Gudjonsson* discloses said the first user device associated with the first realm is connected to the second user device associated with the second realm wherein the first realm includes a first protocol characteristic, the second realm includes a second protocol characteristic, and wherein said first protocol characteristic is different from said second protocol characteristic [column 13 «line 49» to column 14 «line 8»].

Claim 123

Claim 123 is rejected for at least the same reasons set forth for claim 17.

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Claim 124

Claim 124 is rejected for at least the same reasons set forth for claim 22.

Claims 125-127

Auerbach as modified by *Aravamudan* and *Gudjonsson* discloses a portal instant messaging provider and a general instant messaging provider (i.e., service providers) [column 5 «lines 11-37»].

Claim 148

Auerbach does not expressly disclose a service provider providing Internet telephone service. *Aravamudan* discloses an internet service provider providing Internet telephone service and establishing a connection with an Internet service provider that provides Internet telephone service [column 3 «lines 26-66» : “Internet Protocol (IP) telephony” | column 4 «lines 6-25»]. It would have been obvious to one of ordinary skill in the art to incorporate IP telephony devices and service providers into *Auerbach*’s unified messaging system as IP telephony and telephony service providers were well known at the time of *Auerbach*’s invention [see *Aravamudan*, column 1 «lines 37-39»]. One would have been motivated to provide such a combination so as to increase the functionality of *Auerbach*’s system.

Claim 149

Auerbach discloses said realms comprise Internet service providers [abstract].

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B. Claims 112 and 113 are rejected under 35 U.S.C § 103(a) as being unpatentable over *Auerbach et al.*, U.S. Patent No. 6.549.937 [*"Auerbach"*] in view of *Gudjonsson et al*, U.S Patent No. 6.564.261 [*"Gudjonsson"*].

Claim 112

Auerbach as modified by *Gudjonsson* discloses a method of conducting an instant messaging session between a first user device and a second user device over the Internet, the method comprising the steps of:

retrieving an instant messaging protocol suitable for communications with the second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : *Auerbach*'s conversion platform 112 reads on Applicant's claimed database];

establishing a connection from the first user device to the second user device with the suitable instant messaging protocol as part of an instant messaging session [column 7 «line 65» to column 8 «line 40»]; and

encrypting an instant message communication between a first user device and the second user device during the instant message session [*Gudjonsson*, column 2 «lines 16-23» | column 11 «lines 38-43» where: *Gudjonsson*'s servers are interpreted as Applicant's "devices"].

Claim 113

Auerbach as modified by *Gudjonsson* discloses a method of conducting an instant messaging session between a first user device and a second user device over the Internet, the method comprising the steps of:

retrieving one of a plurality of instant messaging protocols that is suitable for communications with the second user device from a database accessible to the first user device

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[Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : *Auerbach's* conversion platform 112 reads on Applicant's claimed database];

establishing a connection between the first user device and the second user device with the retrieved suitable instant messaging protocol [column 7 «line 65» to column 8 «line 40»];

encrypting an instant message communication between the first user device and the second user device during an instant message session using the suitable instant messaging protocol [*Gudjonsson*, column 2 «lines 16-23» | column 11 «lines 38-43» where: *Gudjonsson's* servers are interpreted as Applicant's "devices"]; and

displaying an instant message from the first user device to the second user device using the suitable instant messaging protocol [column 7 «line 65» to column 8 «line 40»].

C. Claims 128-133 are rejected under 35 U.S.C §103(a) as being unpatentable over *Auerbach*, *Aravamudan*, and *Gudjonsson*, in further view of *DeSimone et al*, U.S Patent No. 6.212.548 [*DeSimone*].

Auerbach does not teach peer-to-peer connections but does teach that the invention may be practiced in "distributed computing environments." *DeSimone* discloses establishing peer-to-peer connections for instant messaging [Figure 2B | Figure 3 | column 4 «line 57» to column 5 «line 5»]. It would have been obvious to incorporate peer-to-peer methodology into *Auerbach's* instant messaging system as taught by *DeSimone*. One would have been motivated to provide such a combination as peer-to-peer messaging reduces burden on servers [see *DeSimone*, abstract].

III. CONCLUSION

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452